



UNITED STATES PATENT AND TRADEMARK OFFICE


UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,668	04/11/2001	Ljerka Ukrainczyk	SP01-076	1810
22928	7590	04/14/2004	EXAMINER	
CORNING INCORPORATED			HOFFMANN, JOHN M	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	

1731

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/832,668	Applicant(s) UKRAINCYK ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29-39 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The complex steps and precise control are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). On page 6 of the paper of 3/29/04 applicant states "Fabrication of fiber-optic elements such as lensed fibers require complex steps and precise control...." The claims do not require anything that has precise control.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-39 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the elements that one can use to perform complex steps and precise control.

Art Unit: 1731

ON page 6 of the paper of 3/29/04 applicant argues that: Fabrication of fiber-optic elements such as lensed fibers require complex steps and precise control, such as cannot be expected to be achieved using the various elements of the 1970 houses, such as a kitchen, incandescent bulb, closeable sheet of plywood, refrigerator, oven, and other household elements recited by the Examiner. Since a kitchen does not typically have the structure needed to make a fiber optic element, there must be some other structure needed for the "required" complex steps and precise control. The claims must include the essential structure. If one cannot create a fiber-optic element with the structure in a kitchen, then one cannot create a fiber-optic element with only two chambers, a holder, a filament, a barrier and a positioning device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lestournel 5141378.

Looking at figure 1: there are three chambers (38, 28 and 16) that are normally separated by barriers 34 and 36/60. Either 38 or 16 can be the "first chamber" and either of the remaining two can be the "second chamber". As to maintaining an inert atmosphere: it would have been obvious to make structures as leak-proof as possible,

so as to prevent gases from escaping, or from letting external gases contaminate the chamber. 90 is the fiber holder, it can be used suspend a fiber: the *limitation for suspending a fiber* is an intended use, not structure.

There is no teaching of a filament supported inside the second chamber. However col. 11, lines 5-10 discloses using lighting in the top and bottom chambers. IT would have been obvious to use incandescent lights or halogen lights, because they are relatively inexpensive, and readily available. Incandescent lights and halogen lights have filaments. Line 9 discloses that one can move the lamp – it would have been obvious to have some structure that can be used to move the lamp/filament, because to do it by hand would defeat the purpose of the Lestournel apparatus.

Claim 30 is an intended use limitation that does not further limit the structure beyond what Lestournel discloses.

Claim 31, there are various actuators, for example, see col. 6, line 57 to col. 7, line 25.

Claim 32 is clearly met

Claim 33: see 236 and 232.

Claim 34: see figure 2 feature 228. Most of the limitations are intended use limitations – not structural limitations. Lestournel is clearly capable of performing the functionality as claimed.

Claim 35: it is deemed that camera 242 is such a sensor.

Claim 36: is clearly met. Alternatively, if Applicant does not agree that Lestournel has many of the lower chambers, it would have been obvious to have as many of the

Art Unit: 1731

lower chambers as desired for multiplied effect. It is noted, there would be little need to make a "mobile" chamber if it is not to be moved between various access points/chambers.

Claim 37: The claim refers to a "rotatable member". IT is noted that the specification gives no indication that this is to be limited to the disclosed turntable. It is deemed that the term "rotatable member" reads on anything that can be rotated. Examiner has seen entire houses being moved, thus it is deemed that one could move/rotate the entire, Lestournel building if one so desires. One can rotate the building relative to the mobile first chamber, by removing the mobile intervention chamber from the rest of the building. It is noted that this is not to be construed as saying Lestournel teaches to rotate, nor is it to be construed as saying it would be obvious to rotate: rotation is a method of use limitation. The claims do not require rotation, thus Lestournel need not disclose such. All that is required is that one **can** rotate the member.

Claims 38-39 are clearly met.

Response to Arguments

Applicant's arguments with respect to claims 29-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment and arguments/response necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

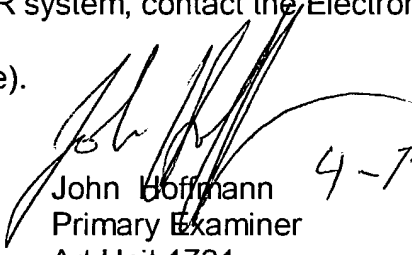
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Hoffmann
Primary Examiner
Art Unit 1731

4-7-04

jmh